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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,403	11/13/2006	Reiner Fischer	2400.0320000/VLC/CMB	1672

26111 7590 08/03/2009

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EXAMINER	
BIANCHI, KRISTIN A	

ART UNIT	PAPER NUMBER
1626	

MAIL DATE	DELIVERY MODE
08/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/578,403	FISCHER ET AL.	
	Examiner	Art Unit	
	KRISTIN BIANCHI	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-6,8,9,11-15 and 17-19* is/are pending in the application.

4a) Of the above claim(s) *17-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-6,8,9 and 11* is/are rejected.

7)☒ Claim(s) *12-15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 2-6, 8, 9, 11-15, and 17-19 are pending in the instant application. Claim 1 has been cancelled by way of amendment filed on April 3, 2009. Claims 17-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected subject matter. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other. Claims 2-6, 8, 9, and 11 are rejected. Claims 12-15 are objected.

Response to Amendment and Remarks

Applicants' amendment, remarks and the declaration by Dr. Heinz Kehne filed on April 3, 2009 have been fully considered and entered into the application. In regards to the nonstatutory obviousness type double patenting rejections over US Patent No. 6,861,391, US Patent No. 6,555,567, US Patent No. 6,479,489, and US Patent No. 5,616,536, the grounds for rejection are moot in view of Applicants' amendment and the rejections have been withdrawn. In regards to the nonstatutory obviousness type double patenting rejections over US Patent No. 5,994,274, US Patent No. 5,981,567, US Patent No. 6,358,887, and US Patent No. 5,462,913, Applicants argue that the claims of the patents listed above disclose thousands of compounds and the Office has not provided a reason why a person of ordinary skill in the art would choose a compound wherein X is chlorine or bromine, Y is C1-C3 alkyl and Z is ethyl, n-propyl or n-butyl as a lead compound from among the thousands of compounds recited by the patents listed

above. Applicants also argue that the rationale the Office has provided is not sufficient to modify the selected lead compound in such a way as to arrive at the current invention and that it would not have been obvious to one of ordinary skill in the art to make the compounds of the instant claims. These arguments are not found to be persuasive. The subject matter (i.e. a compound wherein X is chlorine or bromine, Y is C1-C3 alkyl and Z is ethyl, n-propyl or n-butyl) of the instant invention is still covered or anticipated by US Patent No. 5,994,274, US Patent No. 5,981,567, US Patent No. 6,358,887, and US Patent No. 5,462,913. MPEP § 2144.08.11.A.4(c) states "... consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties". This is the "Genus-Species Guidelines" for examination based on 35 USC 103 and an analogous guideline was followed here for the analysis of obviousness-type double patenting. Applicants' argument that "the rationale the Office has provided is not sufficient to modify the selected lead compound in such a way as to arrive at the current invention" does not apply to the double patenting rejections made over the patents listed above because the rejections do not include modification of the subject matter disclosed in the patents (i.e. the subject matter disclosed in the patents listed above anticipates that of the instant invention and does not need modification). Therefore, the nonstatutory obviousness type double patenting rejections over US Patent No. 5,994,274, US Patent No. 5,981,567, US Patent No. 6,358,887, and US Patent No. 5,462,913 are maintained and

are described below. In regards to the 35 U.S.C. 103(a) rejection over U.S. Patent No. 5,994,274, Applicants argue that the Office has failed to provide a rationale why one of ordinary skill in the art would choose the compounds I-1-a-3 or I-1-a-19 from Fischer as a lead compound from among the hundreds of compounds recited by Fischer. This argument along with the declaration by Dr. Heinz Kehne, which illustrates that compounds of the present invention with an ethyl group at the Z position were far more superior (i.e. at killing weeds) to the compounds from Fischer even at lower levels of application, have been found to be fully persuasive. Therefore, the 35 U.S.C. 103(a) rejection has been withdrawn.

Maintained Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-6, 8, 9, and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No.

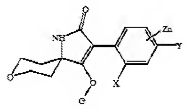
5,994,274. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

U.S. Patent No. 5,994,274 discloses (i.e. claim 1) compounds of formula (I)

wherein X is alkyl, Y can be alkyl, Z can be halogen, Het can be , and A and B, together with the carbon atom to which they are bonded, represent a saturated or unsaturated, optionally substituted carbocycle or heterocycle. Compounds of this formula anticipate compounds of the instant claims. U.S. Patent No. 5,994,274 also discloses the same process of making compounds of formula (I) (i.e. claim 5) as in the instant claims as well as the same methods of using the compounds. Therefore, it would have been obvious to one of ordinary skill in the art to make the compounds of the instant claims given U.S. Patent No. 5,994,274 and to use them in pesticides and/or herbicides for controlling animal pests and/or unwanted vegetation.

Claims 2-5, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5 and 6 of U.S. Patent No. 5,981,567. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

U.S. Patent No. 5,981,567 discloses (i.e. claim 1) compounds of formula



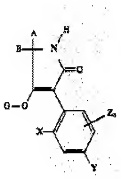
wherein Z can be halogen, n can be 1, Y can be C1-C6-alkyl, and X can be C1-C6-alkyl and these compounds anticipate compounds of the instant claims. U.S. Patent No. 5,981,567 also discloses that these compounds can be used in an arthropodicidal or nematicidal composition and in a method to combat arthropods or nematods. Therefore, it would have been obvious to one of ordinary skill to make the compounds of the instant claims given U.S. Patent No. 5,981,567 and to use those compounds in pesticides and in a method for controlling animal pests.

Claims 2-5, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 7, and 8 of U.S. Patent No. 6,358,887. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

U.S. Patent No. 6,358,887 discloses compounds of formula (I) (i.e. claim 1) wherein X can be halogen, Y can be C1-C6-alkyl and Z can be C1-C6-alkyl and compounds of this formula anticipate compounds of the instant claims. U.S. Patent No. 6,358,887 also discloses methods of combating pests and weeds. Therefore, it would have been obvious to one of ordinary skill to make the compounds of the instant claims given U.S. Patent No. 6,358,887 and to use those compounds in pesticides and/or herbicides in a method for controlling animal pests and/or unwanted vegetation.

Claims 2-5, 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,462,913. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

U.S. Patent No. 5,462,913 discloses (i.e. claim 1) compounds of the formula



and these compounds anticipate compounds of the instant claims. U.S. Patent No. 5,462,913 also discloses that these compounds can be used in an pesticidal, arthropodicidal, nematicidal or herbicidal composition and in a method to combat pests. Therefore, it would have been obvious to one of ordinary skill to make the compounds of the instant claims given U.S. Patent No. 5,462,913 and to use those compounds in pesticides and/or herbicides and in a method for controlling animal pests and/or unwanted vegetation.

Claim Objections

Claims 12-15 are objected for depending on a rejected base claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIN BIANCHI whose telephone number is (571)270-5232. The examiner can normally be reached on Mon-Fri 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed/
Primary Examiner, Art Unit 1626

Kristin Bianchi
Examiner
Art Unit 1626

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